



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,556	02/09/2001	Seog Yeon Han	2950-185P	6169

2292 7590 09/28/2006

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

GYORFI, THOMAS A

ART UNIT	PAPER NUMBER
----------	--------------

2135

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/779,556

Applicant(s)

HAN ET AL.

Examiner

Tom Gyorfi

Art Unit

2135

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-25.
Claim(s) withdrawn from consideration: 26-30.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

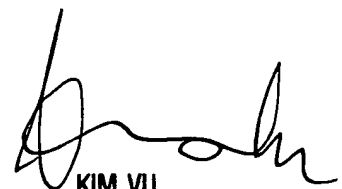
11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of (7) above: Applicant has amended independent claims 1, 4, 8, 13, and 15 to incorporate the limitation of claims 26-30 respectively. Consequently, the current rejections of claims 1-11 and 13-25 under 35 USC 102(b) in view of Kuba, the rejections of claims 1-11 and 13-25 under 35 USC 103(a) in view of Kuba and D-Store, the rejection of claim 12 under 35 USC 103(a) in view of Kuba and ECMA, and the rejection of claim 12 in view of Kuba, D-Store, and ECMA have been withdrawn. However, in view of the amended claims, in conjunction with the fact that claims 26-30 had been rejected under 35 USC 103(a) in view of Kuba and Taussig, thus new rejections of claims 1-11 and 13-25 under 35 USC 103(a) are made in view of Kuba and Taussig, and claim 12 is rejected under 35 USC 103(a) in view of Kuba, Taussig, and ECMA, for identical reasons to those set forth in the Final Office Action of 6/13/06 as applicable.

Upon further consideration, the declaration under 37 CFR 1.132 filed on 5/24/06 will be entered into the record, but it is insufficient to warrant removing the "Conventional Art" tag of Figures 9A and 9B. With respect to the content of the declaration, it is noted that Webster's II New Riverside University Dictionary defines "conventional" as "conforming to established practice or accepted standards". As was pointed out by the Examiner prior to Applicant's filing of the declaration (Final Office Action of 6/21/05, page 3, 2nd paragraph), the ECMA and ISO references - an internationally accepted standard for data storage on removable, rewritable media - discloses the subject matter of Figures 4A, 9A, and 9B in their entirety (Figure 12 on page 4/21, Figure 21 on page 4/28, and Figure 15 on page 4/23, respectively). The declaration merely attests to the fact that the instant invention uses the subject matter of these figures; but at no point in the declaration, nor at any time during prosecution of the instant application, has Applicant provided any evidence whatsoever that any of the figures in question differ from those figures in the cited standard in any meaningful way so as to possess some novel aspect not found in the standard, that would render the content of Applicant's Figures 4A, 9A, or 9B as non-standard or unconventional. Examiner also notes that the portion of the specification relied on in the declaration states that the "file management method" as a whole [and not "file management" as literally recited in the declaration] is in accordance with the instant invention. However, this does not preclude the possibility that certain components of said file management method are themselves conventional; rather, it is the particular combination of all the elements of the file management method, including but not limited to the tables of Figures 4A, 9A, and 9B, that Applicant has declared to be novel and non-obvious. Indeed, following Applicant's argument from the declaration to its logical conclusion, Applicant is apparently arguing that rewritable DVDs are themselves an invention of the instant application, because the claimed file management method uses them (see the declaration of 5/24/06, page 2, lines 1-3). Thus, the conclusion of the declaration does not follow from the evidence presented therein. Furthermore, Examiner once again reminds Applicant that even if the declaration were sufficient to merit removing the "Conventional Art" label from the aforementioned figures, it would not materially affect the current rejection of claim 12 in view of Kuba, Taussig, and ECMA, for identical reasons to those set forth in the Final Office Action of 6/13/06, page 2, last paragraph.

On page 11 of the amendment of 9/13/06, 3rd paragraph, Applicant argues against the previous rejection of Kuba and Taussig (see the Final Office Action of 6/13/06, pages 21-22), stating: "At page 21, lines 15-20 of the Office Action, the Examiner points to column 3, lines 22-38 of Taussig for teachings pertaining to a DVD used in a video camera. However, Taussig at column 3, lines 26-27 teaches 'an 8 cm digital video disk (DVD).' This 8 cm (80 mm) DVD is much larger and thus fundamentally different from the memory card of Kuba (and the micro-drive of D-Store). One of ordinary skill would have no motivation to combine the dissimilar art of Taussig with Kuba to produce a claimed embodiment of the invention, such as is set forth in independent claims 1, 4, 8, 13 and 15." Examiner strongly disagrees with this contention. First, there is no recitation of any size limit to the DVD in the claim language or even in the instant specification. Even if support had existed in the disclosure, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Second, despite Applicant's recognition that at least one embodiment of Kuba can use an opto-magnetic disk or other like media in lieu of the memory card (see page 10 of the amendment, 4th paragraph), Applicant has ignored this fact in Applicant's assessment of the suitability of the combination of Kuba and Taussig. It was well known in the art that opto-magnetic disks are considerably larger than either contemporary memory cards or microdrives, and are approximately the same size as the 80mm DVDs disclosed by Taussig [for illustrative purposes, see http://www.minidisc.org/ieee_paper.html, particularly section VII]; yet Kuba explicitly discloses that such a substitution (the memory card for a considerably larger disc) is permissible. One of ordinary skill in the art would thus have easily recognized that DVDs (with the advantages as stated in the Final Office Action, page 22, and also in the Taussig reference, col. 1, lines 35-45) are a "like large capacity storage media" as recited by Kuba and would be an acceptable, if not superior, alternative to the default memory card embodiment. Third, even if one could plausibly argue that incorporating a DVD into a camera was not desirable - an argument clearly contradicted by the Taussig reference, as well as the previously cited Japanese patents (Final Office Action of 6/13/06, page 22, paragraph #12) - Examiner once again reminds Applicant that Kuba is not limited to camera embodiments, but rather the method can be applied to any general purpose computing device (col. 22, lines 58-61), which would render Applicant's argument regarding the physical size of the media moot. (see also the Final Office Action of 6/21/05, page 2, last four lines)

Applicant is advised that any future attempt to add a limitation in the claim language so as to impose any restriction(s) on the particular size of the DVD or rewritable disk will be rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement by containing new subject matter not previously disclosed in the specification.



KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100